REMARKS

After entry of the amendment, claims 1-26 will be pending. Claim 20 has been amended to replace a period in the text with a comma. Newly added claims 21, 22, and 26 are based, *inter alia*, on the disclosure of Example 12. New claims 23-25 have limitations based on the disclosure at page 36, lines 17-26. No new matter is being added by this amendment.

Claims 1-20 were considered to not comply with the PCT unity of invention requirement, and Applicants are required to elect a single invention for prosecution, from the following claim groups:

I. Claims 1-7, directed to a process for synthesizing escitalopram.

II. Claims 8-14, directed to a process for synthesizing escitalopram.

III. Claims 15-19, directed to a process for synthesizing escitalopram.

IV. Claim 20, directed to escitalopram that contains less than a specified amount of an impurity compound.

The requirement is based on a holding that the claim groups do not share a common technical feature, since the escitalopram compound was previously known.

Applicants respectfully traverse this requirement. None of independent claims 1, 8, and 15 is directed to escitalopram, but to a process for preparing escitalopram. Patentability of these claims does not depend upon whether the recited product was previously known, but depends on what was known regarding methods for preparing the compound. The logical foundation for this requirement is faulty, as it would result in the propositions: if escitalopram is a known substance, then no new process for making escitalopram could be patentable; if escitalopram is a known substance, then no new pharmaceutical formulation including escitalopram could be patentable; and if escitalopram is a known substance, then no new use for escitalopram could be patentable. These results are not in accord with current law or Office policies, as the relationship of the common process features of the claims has not been evaluated, in view of the prior art and with a consideration of both novelty and inventive step.

The independent claims 1, 8, and 15 have a clear technical relationship. The starting material recited in claim 8 can be prepared in step (a) of claim 1 (see Scheme II on page 5 of the specification). Step (a) of claim 15 recites a starting material that can

be prepared in step (b) of claim 1, or in step (a) of claim 8. This relationship continues for new independent claim 21, where the recited starting material can be prepared in step (a) of claim 1.

Independent claim 20 is directed a material that can be prepared by a process of various claims of the application. Examination of this claim will involve a search that is co-extensive with the search for the process claims, and no Office objective can be served by not examining it together with the process claims.

Direction for evaluating unity of invention is provided in M.P.E.P. § 1850:

> Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant.

The instant election requirement obviously has not involved the above-described "broad, practical consideration," and therefore must be considered as being manifestly improper. Withdrawal of the requirement and the simultaneous examination of all pending claims is appropriate, and this action is respectfully solicited.

However, if the requirement is maintained, Applicants hereby provisionally elect the claims of Group II (claims 8-14), plus new dependent claim 26, for examination.

If any matters remain to be resolved in connection with this submission, please contact the undersigned by telephone or facsimile to expedite resolution.

Respectfully submitted,

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